

Hearing:  
August 3, 2004

This Opinion is Not  
Citable as Precedent  
of the TTAB

Mailed:  
September 28, 2004

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Gregory

Serial No. 76442899

Paul J. Vincenti of Vincenti & Vincenti, P.C. for Rogan S. Gregory.

Christopher L. Buongiorno, Trademark Examining Attorney,  
Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hohein, Holtzman and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Rogan S. Gregory (an individual) has applied to register ROGAN (stylized) on the Principal Register as a trademark for goods identified as "fabric handbags, leather handbags and wallets," in International Class 18, and "pants, shirts, and footwear" in International Class 25. The application is based on applicant's stated use of ROGAN as a mark in commerce since March 2000, such date being applicable to both classes. Because the degree of

stylization of the proposed mark is a factor in our analysis of the refusal, the mark is reproduced below:

**I'OGAN**

The examining attorney has refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C.

§1052(e)(4), on the ground that ROGAN (stylized) is primarily merely a surname. When the refusal was later made final, applicant filed a notice of appeal.<sup>1</sup> Applicant and the examining attorney filed briefs and appeared at an oral argument before the Board.

At this point, we note that a related application, which sought registration of ROGAN in typed form on the Principal Register for the same goods involved herein (as well as for certain other goods) was examined by a different examining attorney who created a different record. Applicant's arguments and evidence in support of registration of the stylized version of ROGAN, however, are largely the same as were presented in the other application. This panel of the Board affirmed the refusal of registration in the earlier application, and our

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<sup>1</sup> The final refusal noted for applicant the option of amending the application to seek registration on the Supplemental Register. No such amendment was made.

decision is reported at In re Gregory, 70 USPQ2d 1792 (TTAB 2004).

In the case at hand, the first office action setting forth the refusal of registration stated the examining attorney's view that the "stylization of lettering in the mark does not change the surname significance." As evidence to support the refusal, the examining attorney attached to the action the first 10 listings he was able to retrieve from [www.people.yahoo.com](http://www.people.yahoo.com), to "illustrate the surname significance of the mark." Additional evidence attached to the examining attorney's subsequent office action finally refusing registration are reprints of the first 200 listings of individuals with the surname "Rogan," retrieved from the "USFIND Person Locator - Nationwide" database, available through the LEXIS online research service. The introductory summary of the results of the search indicates that there were 2,229 "hits" when the search was conducted. Finally, with his brief, the examining attorney submitted photocopies of pages from three dictionaries and a request that we take judicial notice that "Rogan" does not appear in any of the three.<sup>2</sup>

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<sup>2</sup> These are Merriam-Webster's Geographical Dictionary, Merriam-Webster's Collegiate Dictionary, and the Cassell Dictionary of Proper Names.

Responding to the examining attorney's request that we take judicial notice of the absence of entries for "Rogan" in three different types of dictionaries, applicant asserted in his reply brief that the submissions were made too late but that he would not object to their consideration so long as the Board would also take judicial notice of certain Internet-based "baby name dictionaries and directories" which assertedly show that "Rogan" has "first name significance."<sup>3</sup>

In our experience, it unfortunately has become all too common for examining attorneys and applicants to delay submitting readily available evidence, particularly dictionary definitions, until the briefing of an appeal. This practice deters thorough discussion by examining attorneys and applicants of the weight to be accorded evidence.<sup>4</sup> In this case, we deny the respective requests that we take judicial notice. As for the examining attorney's request, while the Board has often taken

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<sup>3</sup> The web page addresses include: [www.baby-names-world.com](http://www.baby-names-world.com), [www.parentsplace.com](http://www.parentsplace.com), [www.pregnancy.about.com](http://www.pregnancy.about.com), [www.babynameworld.com](http://www.babynameworld.com), and [www.dublinuncovered.net/irishnames](http://www.dublinuncovered.net/irishnames).

<sup>4</sup> Requests that the Board take judicial notice of dictionary definitions should at a minimum be set forth in the main briefs of the applicant and examining attorney, so that the examining attorney will have an opportunity to respond to what an applicant addresses in its main brief and the applicant will, with its reply brief, have an opportunity to respond to whatever the examining attorney may advance in a main brief.

judicial notice of dictionary definitions, not one of the authorities on which the examining attorney bases his request stands for the proposition that we may, or must, take judicial notice of the absence of a definition from a dictionary.<sup>5</sup> As for the applicant's request, Internet web pages are not proper subjects for judicial notice. See In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999) (Board refused to take judicial notice of definitions from online dictionary not also available in printed form). See also, Raccioppi v. Apogee Inc., 47 USPQ2d 1368 (TTAB 1998). Accordingly, we will not consider the arguments made by either the examining attorney or by applicant which rely on the materials covered by the respective requests that we take judicial notice.

Having reviewed the evidence properly submitted by the examining attorney and having addressed the respective requests made during briefing that we take judicial notice, we now review the evidence submitted by applicant. This

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<sup>5</sup> While in the case of American Security Bank v. American Security and Trust Co., 571 F.2d 564, 197 USPQ 65, 67 n.1 (CCPA 1978), judicial notice was taken of the absence of a listing from a telephone directory, we view that decision as distinguishable and limited to its particular facts. Moreover, it does not appear that, in this case, the examining attorney is merely seeking to have us judicially notice the fact that listings do not appear but rather the "fact" that, because there are no listings, ROGAN is not a recognized place name, first name or name of a food item, as applicant contends. In this regard, the examining attorney seeks too much from judicial notice.

includes a declaration of applicant's counsel used to introduce searches from the website [www.hamrick.com/names.html](http://www.hamrick.com/names.html), illustrating the geographic distribution of the surnames ROGAN, HACKLER, KELLY and SMITH in the United States; a plain, i.e., uncertified copy of applicant's registration of a stylized letter "r," covering the goods involved herein;<sup>6</sup> an Internet web page showing the results of an "atlas query" that lists various place names (Rogan in the Ukraine; Rogana in Tennessee; Rogans Hill in Australia; and Roganville in Texas); two Internet web pages featuring recipes for an Indian dish named "rogan josh" (described as "one of the classic Mogul dishes,"<sup>7</sup> it may be prepared with lamb or beef and is reported to translate as "red meat"); and one web page featuring a variation on rogan josh listed as "chicken rogan."

The USPTO has the burden of establishing a prima facie case that a term is primarily merely a surname. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652,

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<sup>6</sup> The display of the letter "r" is identical to the display of the first letter of the mark involved in this appeal. The registration does not include a description of the mark, but applicant states it is "a stylized 'r.'"

<sup>7</sup> We take judicial notice of the following: "**Mogul**, n. 1. one of the Mongol conquerors of India who established an empire that lasted from 1526 to 1857. 2. one of their descendants. ..." The Random House College Dictionary 858 (rev. ed. 1982).

653 (Fed. Cir. 1985). Moreover, "[t]he question of whether a word sought to be registered is primarily merely a surname within the meaning of the statute can only be resolved on a case by case basis," taking into account a number of various factual considerations. Id.

There are five accepted factors to be considered in the analysis:

- (1) Is the word a common or rarely used surname?
- (2) Does anyone connected with the applicant have that surname?
- (3) Does the word have meaning other than as a surname?
- (4) Does the word look and sound like a surname?
- (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression?

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995) (Examining attorney's refusal to register BENTHIN reversed, because it was a rare surname, did not look and sound like a surname, and was set forth in a highly stylized oval design).

As to the first factor, applicant argues that the existence of approximately 200 listings of ROGAN in one database and 2200 in another, out of an asserted 90 million

listings covered by the databases, evidences that the ROGAN surname is rare.<sup>8</sup> Also, applicant has argued that his searches of the hamrick.com website show that individuals with the ROGAN surname are scattered in small numbers around the United States. Finally, applicant argues that the Board previously has found HACKLER to be a rare surname and that, in terms of frequency of occurrence throughout the various states, HACKLER and ROGAN appear with just about the same frequency. (According to applicant's analysis, in 41 of 50 states ROGAN appears approximately once in every 8,500 names and in 40 of 50 states, HACKLER appears approximately once in every 8,500 names.) See In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000) (Board reversed refusal to register HACKLER).

We do not view the *United Distillers* decision as setting a per se benchmark stating that unless there are

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<sup>8</sup> In fact, there is nothing in the record that reveals the total number of listings in either of the databases searched by the examining attorney in this case. In the prior appeal of the refusal to register ROGAN in typed form, we accepted applicant's contention that the search by the examining attorney in that case of the ReferenceUSA database involved a search of a database with 90 million listings. This was based in part on applicant's contention that the Phonedisc database discussed in other, unrelated cases had 80 million listings and the Phonedisc database had been renamed the ReferenceUSA database and had expanded. In the case at hand, applicant appears to be assuming that the www.people.yahoo.com and "USFIND Person Locator - Nationwide" databases have the same number of listings as the ReferenceUSA database.



many more than 1300 listings in a database of telephone listings, or unless a surname appears with more frequency than HACKLER, the surname must be found to be a rare. First, we note that the decision is somewhat equivocal on the rareness factor, for it initially states that HACKLER "is a rare surname" but later refers to "this *relatively* rare surname" (emphasis added). More importantly, the decision does not rely solely on the database figures to reach a conclusion on the rareness factor. The *United Distillers* decision also relied on the absence of any significant number of listings for the HACKLER surname from telephone directories for certain major metropolitan areas (the borough of Manhattan in New York City and the Washington, DC/Northern Virginia areas). *United Distillers*, 56 USPQ2d at 1221. Similarly, in the *Benthin* decision, the conclusion regarding rareness was based not only on a low number of database listings (slightly over 100) but also on the absolute absence of listings from the Boston, Manhattan and Philadelphia directories. *Benthin*, 37 USPQ2d at 1333.

We conclude that the question whether a surname is or is not rare is not to be determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database. Given the large

number of different surnames in the United States, even the most common surnames would represent but small fractions of such a database. The listings the examining attorney excerpted from his search of the "USFIND Person Locator - Nationwide" database show that individuals with the surname Rogan live in states up and down the East and West Coasts, in the Midwest, South and Southwest. Accordingly, we conclude that ROGAN is not a rare surname. We are not persuaded otherwise by applicant's evidence showing that KELLY and SMITH are much more common surnames than HACKLER or ROGAN.

As to the second factor, applicant asserts that ROGAN is his first name and not the surname of any individual connected with him. The examining attorney has conceded this factor, apparently concluding that it therefore favors applicant. We, however, find the factor neutral. We note, in this regard, that applicant does not claim that he promotes recognition of the ROGAN name as a first name. In a situation wherein an individual applicant, or an officer or employee, for example, of a corporate applicant, actually has the surname proposed as a mark, this would certainly weigh against the applicant. *Benthin*, 37 USPQ2d at 1333 (even though Benthin was ultimately found not primarily merely a surname, the second factor weighed

against the applicant because Benthin was the surname of applicant's Managing Director). In contrast, that a proposed mark is not the applicant's surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname.

Applicant and the examining attorney obviously differ on the question of whether ROGAN has significance other than as a surname. The examining attorney asserts that ROGAN has no meaning other than as a surname. Applicant relies on the fact that ROGAN is his first name; on the Internet "atlas query" and his contention that the results of this query show that ROGAN is the root of certain place names; and on the evidence that there is an Indian dish known as "rogan josh."

Applicant has not put anything in the record to show how commonly ROGAN is used as a first name rather than a surname, while we have a good deal of evidence of its use as a surname. Cf. In Re Harris-Intertype Corporation, 518 F.2d 629, 186 USPQ 238, 240 (CCPA 1975) (dictionary listing of HARRIS as given name noted that it is derived from a surname). As to the results of the atlas query, we agree with the examining attorney that the apparent existence of a place named "Rogan" in the Ukraine and "Rogans Hill" in

Australia is not evidence of whether consumers in the United States will perceive ROGAN as having a non-surname meaning. In re Sava Research Corp., 32 USPQ2d 1380, 1381 (TTAB 1994). On the other hand, while the existence of places named "Rogana" and "Roganville" in, respectively, Tennessee and Texas, can be considered as probative evidence because these uses are in the United States, the existence of Roganville may actually support the conclusion that "Rogan" would be viewed as a surname by individuals in that place (or familiar with it). *Harris-Intertype*, 186 USPQ at 239 (CCPA 1975) (cities, counties, streets, lakes and other things may derive their names from an individual's name).<sup>9</sup> Moreover, there is nothing in the record to show that any of these places are so well known that the geographic significance of, for example, Roganville as a place name would overshadow the surname significance of the term ROGAN. Cf. In re Colt Industries Operating Corp., 195 USPQ 75 (TTAB 1977) (significance of FAIRBANKS as a well-known city in Alaska at least equal to its surname significance).

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<sup>9</sup> While Roganville has the look of a place name created by coupling "Rogan" and the common suffix "ville," Rogana is different. It does not have the look of a place name made by coupling "Rogan" with the letter "a."

We also accord little weight to the existence of the Indian dish "rogan josh." There is nothing in the record to indicate whether the dish is actually available at Indian restaurants in the United States and, if so, how widely. The web site setting forth a recipe for "chicken rogan" appears to be a web site based in the United Kingdom ([www.miketaylor.org.uk/misc/recipes/rogan.html](http://www.miketaylor.org.uk/misc/recipes/rogan.html)), and also is unsupported by evidence that diners or cooks in the United States would be familiar with it.

We conclude that the clearly dominant meaning of ROGAN is as a surname and would at most have but some obscure association with minor localities or Indian food. This factor therefore favors the examining attorney's refusal of registration.

The next factor to be discussed is whether ROGAN has the look and sound of a surname. When a term does not have the look and sound of a surname, it clearly aids the applicant. On the other hand, when it does look and sound like a surname, such a finding merely tends to reinforce a conclusion that the term's primary significance is as a surname.

We conclude that ROGAN has the look and sound of a surname. It would not be perceived as an initialism or acronym, *see Sava, supra*, and does not have the appearance

of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix. Rather, ROGAN appears to be a cohesive term with no meaning other than as a surname.

We turn, then, to the last factor to be considered, i.e., whether the degree of stylization of ROGAN is distinctive enough to create a separate, non-surname impression.

Applicant's stylization of ROGAN is in a block lettering style, mixing lower case (the leading "r" and final "n") and upper case (the middle letters "OGA") but in a way that presents them as being the same size.<sup>10</sup> Further, the look of the lettering is that which might be achieved by hand stenciling. We find nothing in applicant's mixing of upper and lower case block letters, or in the hand-stenciled look of the letters, that would suffice to create a distinct commercial impression apart from the impression that this term is someone's name. Considering the specimens applicant has submitted and how they might influence consumer perception, we note that one specimen is a very dark photocopy of what appears to be either a denim

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<sup>10</sup> We have no way of knowing whether applicant intends the "O" in his proposed mark to be perceived as an upper or lower case letter. We acknowledge some might perceive it as a lower case letter. Even if it could be assumed that all potential consumers might view it so, it would not change our decision.

article of clothing or a denim fabric handbag. If the proposed mark was on this item when it was photocopied, the photocopying has obscured it, for we do not see it at all. The other specimens are fabric labels of the sort that would be sewn into a garment or handbag, and contain lines for listing one's name and address, as well as a manila hang-tag, with a partially obscured address and the phrase "A LITL BETr" (with the letters of this phrase in plain sans serif type and the concluding lower case "r" set forth in the same size as the other letters and in the style of the proposed mark).

We do not consider it appropriate to assess whether applicant's display of ROGAN on the manila hang-tag creates a distinct commercial impression because of the method of its display, for it is a different form of display than that which applicant seeks to register.<sup>11</sup> Turning to the fabric labels that could be sewn into a garment or handbag, we see nothing in applicant's method of actual use of the proposed mark that would change our conclusion that the mixed upper and lower case lettering and hand-stenciled

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<sup>11</sup> We are not dealing with the question whether the hang-tag would support an application to register ROGAN in typed form. If that were the question we might in our analysis rely on a variety of displays. In this case, however, applicant is seeking registration of a particular form of display. Thus, we confine our analysis to the likely perception of the specimens that show that display.

look of the lettering fail to create a distinct commercial impression.

We are not persuaded otherwise by applicant's reliance on the USPTO's issuance of a registration for his stylized letter "r" mark. Applicant contends that issuance of this registration establishes that the letter mark has been found by the USPTO to be "arbitrary and fanciful and, thus, highly stylized." Because applicant also contends that the letter "r" is the "focal point" of the proposed mark involved herein, he concludes that the proposed mark cannot have the look and sound of a surname. We disagree with applicant's conclusions about the significance of the prior registration. First, there is no per se prohibition against registering a single letter (whether in ordinary type or stylized) as a mark; and thus the mere registration of applicant's "r" mark does not establish one way or the other whether the fact of registration means the letter must be perceived as "arbitrary or fanciful." Second, applicant has not established that either the examining attorney who approved the letter mark for publication for opposition, or this Board, ever stated a conclusion about the letter mark. Finally, it is only supposition on



applicant's part that consumers would view the letter "r" as the focal point of applicant's involved mark.<sup>12</sup>

Applicant and the examining attorney, furthermore, disagree about the significance of a non-citable decision of the Board finding another party's mark to be particularly stylized and therefore not primarily merely a surname. As one would expect, applicant considers his mark just as stylized, and the examining attorney considers applicant's mark far less stylized than the other mark that was registered. The Board's policy not to consider prior decisions unless they are issued as citable precedent is often-stated. Thus, notwithstanding the willingness of applicant and the examining attorney to discuss this case, we shall not. More importantly, as noted earlier in this decision, each case involving a refusal of registration under Section 2(e)(4) must be considered on its own merits and comparisons to other cases are not generally helpful. See In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

Balancing the various factors, we find that ROGAN is not a rarely used surname, that it has the look and sound

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<sup>12</sup> The "focal point" argument might have more logic behind it if the involved mark were the mark on the manila hang tag specimen, which has a letter "r" much larger than the other letters in ROGAN. However, as discussed herein, we have disregarded that specimen.

of a surname, and that its primary significance as a surname is not outweighed by other meanings which may be ascribed to the term or by the stylized form of lettering employed by applicant. See *Harris-Intertype, supra*, and In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993).

Decision: The refusal of registration under Section 2(e)(4), on the ground that ROGAN (stylized) is primarily merely a surname, is affirmed.